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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,983	05/08/2000	GUSTAVO DECO	P000861	5072

21171 7590 07/28/2004

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WASHINGTON, DC 20005

EXAMINER
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OROPEZA, FRANCES P

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/530,983

Applicant(s)

DECO ET AL.

ad

Examiner

Frances P. Oropeza

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

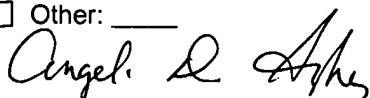
Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-18.

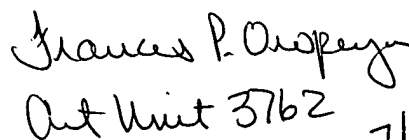
Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_



ANGELA D. SYKES

SUPERVISORY PATENT EXAMINER

  
Art Unit 3762

7/23/04

Continuation of 5. does NOT place the application in condition for allowance because:

The Applicant's arguments filed 6/28/04 have been fully considered but they are not convincing.

1) The Applicant asserts the motivation to combine the teachings of the references is not immediately apparent and the Examiner has the duty to present actual evidence and make particular findings related to the motivation to combine the teaching of the reference to explain why the combinations of the teachings is proper.

With each rejection and each response to the arguments, the Examiner has provided what is deemed to be clear reasoning regarding the motivation for combining the reference. The Examiner will again define the motivation for combining Ravdin et al with Smyth. Ravdin et al. disclose a method for predicting the future occurrence of non-existent medical conditions (abstract, lines 1-3) by evaluating data using a neural network so the medical condition can be predicted (col. 2 @ 43-50) enabling the selection of appropriate therapy (col. 1 @ 25-28). It is clear that an accurate and comprehensive understanding of the future disease state is important to Ravdin et al because it enables treatment to be provided to prevent or minimize the diseased state (col. 1 @ 25-34). Smyth teaches the prediction of future states using the categories of faults, or in the instant case categories of potential medical conditions, to identify what conditions might appear, the probability that these conditions will appear, and to determine if the disease conditions currently exist (abstract; col. 2 @ 37-53; col. 5 @ 46 - col. 6 @ 8). Given the Smyth teaching that the status of multiple potential disease states can be known, one would obviously be motivated to combine the teaching of Smyth with Ravdin et al. to have a more complete understanding of the patient's future health, this knowledge enabling robust decision making relative to potential treatments (abstract) and improving the reliability and accuracy of the decision system that is predicting future states (col. 22 @ 66 - col. 23 @ 1).

2) The Applicant asserts the obviousness modification rationale relies on unsupported conclusory motivation, and the rejection requires concrete evidence of motivation in the record be defined that would lead one skilled in the art to combine the relevant teachings. The Examiner disagrees that the motivation to combine is unsupported. As noted in paragraph 1) above, the rationale along with cited references is provided to give concrete evidence of the motivation to combine the references.

3) The Applicant asserts there must be some link between the solution in Smyth and the need/desire of the same in Ravdin et al., and the current motivation only relates to the benefits of Smyth. The Examiner disagrees. As noted in paragraph 1) above, Ravdin et al. wants an optimum understanding of the disease condition, so treatment can be provided. Smyth optimizing the understanding of the patient's condition by providing knowledge of multiple potential disease states, hence the need/ desire is evident in Ravdin et al..

4) The Applicant asserts Smyth and Ravdin et al. do not disclose "information flow" because the "information flow of the instant invention describes the development of a predictability of plural future states". The Examiner disagrees. As noted in paragraph 1) above, Smyth teaching enables the understanding of "plural future states" which is the aspect of the limitation that the Examiner understands is the focus of the Applicant assertion.

5) The Applicant asserts Smyth teaches estimating only the present state based on the determined probabilities (col 5 @ 46 - col. 6 @ 8) versus the instant invention which "describes a development of a predictability of plural future system states". The Examiner disagrees. As discussed in paragraph 1) above, Smyth is read to teach "development of a predictability of plural future system states".

6) In response to the Applicant's arguments that the references fail to show certain features of the Applicant's invention, it is noted that the features upon which the Applicant relies (i.e., and exact mathematical definition discussed in the present invention, the invention's solution set, considering p steps into the future, a corresponding advanced and efficient method and its mathematical definition of the comparison of "information flow with "comparative information flow") are not recited in the rejected claims(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir 1993).

For the reasons of record and the discussion above, the rejection of record stands.

HO  
7/23/04